

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARDUNIVERSITY OF SOUTHERN  
CALIFORNIA

Opposer,

v.

UNIVERSITY OF SOUTH CAROLINA,

Applicant.

Opposition No. 91125615

Serial No. 75/358,031

Mark: SC (Stylized)

Filed: September 16, 1997

Published: May 18, 1999

**Reply in Support of California's Motion to Dismiss**

The Board should dismiss Carolina's counterclaim against California's SC Interlock registration under the *Morehouse* doctrine. Carolina seeks to avoid the *Morehouse* doctrine by (1) noting several differences between the California's SC Interlock registration and its prior, incontestable, SC Word Mark registration, and (2) arguing that California has not established equities to warrant *Morehouse*. But the differences between the SC Interlock and Word Mark registrations are insubstantial, and *Morehouse's* purpose is to prevent inequity to a prior registrant that would occur if its incontestable trademark rights were not respected.

**1. The differences between California's SC Interlock registration and its SC Word Mark registration are insubstantial.**

As California established in its Motion to Dismiss and Carolina does not dispute, a typed drawing and a stylized drawing are equivalent for *Morehouse* purposes. Therefore, the only difference between the registrations could relate to their goods and services. Carolina notes the identifications are not identical, but that is not enough to avoid *Morehouse*. If *Morehouse* were so strictly limited, it would essentially be a dead letter. Trademark registrants have no need (and



indeed cannot) obtain exactly duplicative registrations. Trademark owners do, however, have an incentive to obtain closely related registrations—the latter registration can be for the mark in a slightly different format, or be for slightly different goods and services, or both. And that is the situation at hand. These separate, but related, registrations benefit the public as well as the trademark owner. They provide the public with more thorough notice of the trademark owner's rights, so the public can avoid infringing those rights.

Carolina makes much of the "channels of trade" identification in the SC Word Mark registration, which specifies that the registration is for "university authorized channels of trade" (or in class 25 for "goods being offered and sold at university-controlled outlets"). But a close reading of Carolina's opposition reveals a startling fact: Carolina does not contest that its own goods are sold through "university authorized channels of trade." Although Carolina denies it sells goods at "outlets which are controlled by [California]", it says nothing about the "university authorized" limitation, which is the exact language listed in three of the four classes of the SC Word Mark registration. The reasons for Carolina's silence is apparent—stores that sell university logo products often sell products for many different universities. Accordingly, Carolina did not and cannot dispute that both universities' goods are sold through "university authorized channels of trade."

Moreover, the goods in both registrations are all of an easily recognizable type; they are products that alumnae and fans commonly buy to show their support for their university. The SC Interlock registration is in some ways "broader" than the SC Word Mark registration, but that is not enough to avoid *Morehouse*. The Board has applied *Morehouse* when a second registration

is broader than the first registration.<sup>1</sup> As with the channels of trade, Carolina's protestations about the different goods are "much ado about nothing." Carolina did not and cannot dispute that all of the goods in both registrations are of the type sold by Carolina and, more generally, of the type that are widely sold by universities throughout the country to their supporters.

**2. This proceeding's equities support application of *Morehouse*.**

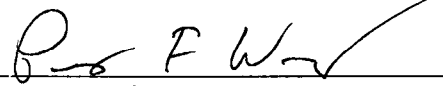
The purpose of the *Morehead* doctrine is do equity: it prevents a party from in effect harassing its opponent by opposing applications or canceling registrations that are substantially identical to a prior registration (which in many cases, such as this one, is incontestable).

*Morehead's* purpose will be furthered by its application in this proceeding. Carolina had legal notice of California's assertion of rights in the SC mark when California filed its SC Word Mark for registration fifteen years ago. California need make no showing of equities beyond establishing that it meets the *Morehouse* criteria, which it has done. Accordingly, the Board should grant its Motion to Dismiss.

Dated: March 10, 2005.

Respectfully submitted,

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<sup>1</sup> See *S & L Acquisition Co. v. Helen Arpels, Inc.*, 9 U.S.P.Q.2d 1221 (T.T.A.B. 1987), discussed in California's Motion to Dismiss.

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**Certificate Of Mailing and Service**

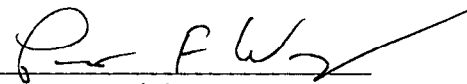
I hereby certify that I am depositing the foregoing Reply in Support of California's Motion to Dismiss in the United States mail, first class, postage pre-paid, on March 10, 2005, addressed to the following:

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

I hereby certify that a true and correct copy of the foregoing Reply in Support of California's Motion to Dismiss is being placed in the United States mail, first class, postage pre-paid, on March 10, 2005, addressed to the following:

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